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09/765,533	01/19/2001	Helen Hardman Howlett-Campanella	HOWLETT-38283	1419

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ART UNIT	**PAPER NUMBER**
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/765,533
Filing Date: January 19, 2001
Appellant(s): HOWLETT-CAMPANELLA, HELEN HARDMAN

Scott W. Kelley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 6, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1 and 3-23 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,645,494	Dionne et al	7-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 23 is rejected under 35 U.S.C. 112 first paragraph. This rejection is set forth in a prior Office Action, mailed on May 14, 2003.

Claims 1 and 3-23 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on May 14, 2003.

(11) Response to Argument

Appellant's amended drawing filed October 6, 2003 is considered new matter and has not been entered. Formal Drawings filed February 11, 2004 is considered new matter and has not been entered.

Appellant's declarations filed October 6, 2003 have been entered and considered.

1. The statements provided by the Declaration of Campanella indicate no clear showing why they were not presented earlier. The declaration statements reflect mere opinions. No factual evidence has been presented to overcome the rejection mailed October 6, 2003. Appellant's statements #8-21 state the difference between the intended use of the instant invention and the intended use of the prior art reference. For example, in statement #8, "My application is directed to a yoga mat," and in statement #9 "Dionne fails to disclose a yoga mat; only a golf mat." In statement #16, "A standing position is only one part of yoga and even then, the golf mat of Dionne would not be appropriate for yoga exercises that involve standing." A recitation of the intended use of

the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The statements provided by the Declaration of Ferris indicate no clear showing why they were not presented earlier. No factual evidence has been presented to overcome the rejection mailed October 6, 2003. In statement #5, the Appellant states, "Various figures of the above-identified include circular indicia at several different intersections of lines." The Examiner contends that Figures 1-8, as originally filed, in the instant application do not clearly and concisely disclose in the specification, neither claims nor drawings subject matter related to markers. Formal Drawings filed on February 11, 2004 [Exhibit A] reflect additional handwritten lines [and labeling] that were not originally filed. Furthermore, the limitations set forth in new claim 23 [e.g. "wherein said first center line, said second center line, said plurality of first lines and said plurality of second lines provide a plurality or rectangles upon said mat, wherein said plurality of rectangles are separated into six non-overlapping sets of four quadrants defining a unit area on opposing sides of said second center line wherein each set of said four quadrants has a center point; and a plurality of markers wherein a single marker is located on selected intersections of said plurality of second lines with said first line and at each said center point of each set of four quadrants) do not support the disclosure as originally filed. Additionally, Claim 23 have been rejected under 35 U.S.C. 132 as

containing new subject matter and under 35 U.S.C. 112, first paragraph as containing new subject matter in the Office Action mailed October 6, 2003.

Regarding the 'mark' definition on page 16 of Appellant's brief: The examiner cannot argue the written definition of any term. The examiner's position is that the identification of a 'mark' or 'marker' in the instant application has been arbitrarily and informally labeled based upon a newly discovered reference to Marquez (claim 9). The newly presented limitations of claim 23, specifically lines 10-18 are not supported by the original disclosure. The Appellant has attempted to convince USPTO to declare interference based upon an application that was not in condition for allowance. The Appellant's argument is based upon *if Marquez uses the term 'marker' to describe circular indicia, then the Appellant should be entitled to use the term as well* (Brief, pg 16, lines 2-3). The examiner argues that in the instant application, the term 'marker' was not clearly and concisely disclosed in the original specification to warrant entry into the instant application. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

L. Amerson
October 4, 2004

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